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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,491	01/20/2004	Michael P. Whitman	11443/173	4374
26646	7590	06/14/2005	EXAMINER	
KENYON & KENYON ONE BROADWAY NEW YORK, NY 10004			ROBERT, EDUARDO C	
			ART UNIT	PAPER NUMBER
			3732	

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/761,491	Applicant(s) WHITMAN	
	Examiner Eduardo C. Robert	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 15-40 is/are pending in the application.
- 4a) Of the above claim(s) 15-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/13/05</u>   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

Newly submitted claims 15-40 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: claims 1-5 (Group 1) were originally filed and are directed to an electromechanical driver, flexible shaft, and surgical attachment assembly classify in 606/219; new claims 15-22 (Group 2) are directed to a surgical attachment classify in 606/1; new claims 23-29 (Group 3) are directed to a surgical system classify in 227/2; and new claims 30-40 (Group 4) are directed to a stapler classify in 227/175.1.

Group 1, elected by original presentation, and Group 2 are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not need that the moveable element being coupled via a torque translating member to the torque generating element and that the at least one selectively movable element being configured to selectively move the moveable element. The subcombination has separate utility such as cutting device, e.g. a reamer or burr.

Group 1, elected by original presentation, and Group 3 are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations

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(MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not need a torque translating member coupled at a first end to the torque generating element or the moveable element coupleable to a second end of a torque translating member or that an amount of torque generated by the torque generating element correspond to the data. The subcombination has separate utility such as cutting device.

Group 1, elected by original presentation, and Group 4 are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not need a first jaw or a second jaw. The subcombination has separate utility such as a stapler.

Group 3 and Group 2 are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not need at least one selectively moveable element being configured to selectively move the moveable element. The subcombination has separate utility such as a cutting device.

Group 2 and Group 4 are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not need a first and second jaws. The subcombination has separate utility such as a stapler.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group 1 is not required for Group 2-3, restriction for examination purposes as indicated is proper.

**Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for**

**prosecution on the merits. Accordingly, claims 15-40 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.**

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Hooven et al.

(U.S. Patent 5,433,721 cited by applicant).

Hooven et al. disclose an electromechanical driver, flexible shaft, and surgical attachment assembly (see for example Figures 13-16). The flexible shaft includes a flexible sheath having a first end and second end, and at least one flexible torque member and at least one electrical connection wire (see col. 7, line 33, through col. 10, line 2). The flexible torque member is coupleable to a surgical attachment, i.e. stapler, at one end and to a drive element at a second end (see Figures 13-16 and col. 7, lines 33, through col. 10, line 2). The surgical attachment, i.e. stapler, has at least one moveable element, a sensor mechanism, and transmitter and receiver (see col. 7, lines 33, through col. 10, line 2). The driver element includes a motor and microprocessor with display including lights.

Applicant is reminded that an anticipation under 35 U.S.C. 102(b) or 102(e) is established when a single prior art reference discloses, either expressly or under principles of inherency, each and every element of a claimed invention. *RCA Corp. v. Applied Digital Data System, Inc.*,

730 F.2d 1440, 221 USPQ 385 (Fed. Cir. 1984). Furthermore, it is well settled that the law of anticipation does not required that the reference teach what appellant is teaching or has disclosed, but only that the claims on appeal “read on” something disclosed in the reference, i.e. all limitation of the claims are found in the reference. *Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1083). Moreover, it is not necessary for the applied reference to expressly disclose or describe a particular element or limitation of a rejected claim word for word as in the rejected claim so long as the reference inherently discloses that element or limitation. *Standard Havens Products Inc. v. Gencor Industries Inc.*, 953 F.2d 1360, 21 USPQ 2d. 1321 (Fed. Cir. 1991).

### ***Response to Arguments***

Applicant's arguments filed on March 29, 2005 have been fully considered but they are not persuasive.

In response to applicant's argument that Hooven et al. do not disclose a sensor mechanism, it is noted that Hooven et al. clearly disclose sensor mechanisms as stated in col. 7, lines 33, through col. 10, line 2, of Hooven et al. patent. Also, applicant has noted that Hooven et al. disclose sensors mechanism. Now, with regard to the functional language “for sensing and providing data concerning at least one feature of the environment surrounding said attachment”, it is noted that the law of anticipation does not require that the reference “teach” what the subject patent teaches, but rather it is only necessary that the claims under attack “read on” something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, **the manner in which a device is intended to be employed does not differentiate the claimed**

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**apparatus from prior art apparatus satisfying the claimed structural limitations.** Ex parte Masham, 2 USPQ2d 1647 (1987).

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

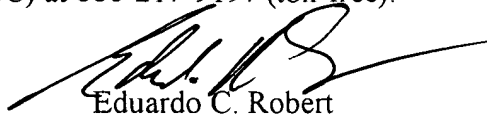
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eduardo C. Robert whose telephone number is 571-272-4719. The examiner can normally be reached on Monday-Friday, 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver can be reached on 571-273-4720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eduardo C. Robert  
Primary Examiner  
Art Unit 3732

E.C.R.